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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/497,176	02/03/2000	Pierre Ardaud	022701-863	7179

21839 7590 06/13/2003

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/13/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/497,176

Applicant(s)

ARDAUD ET AL.

Examiner

Rabon Sergent

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 1-51 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Throughout prosecution, based on the disclosure, the examiner has interpreted the language, "... having a degree of liberation with respect to the masking agent at 120°C of 5% or less", to mean that 5% or less of the masked isocyanate groups deblock at 120°C. This interpretation is logical, since one would expect that the reference to liberation means freeing the masked isocyanate groups. However, applicants have, by their response of April 15, 2003, cast uncertainty on the meaning of the language. Applicants have stated at page 4 of the response that the aforementioned language means that at 120°C no more than 5% of the isocyanate functions remain masked. Applicants' interpretation is completely opposite what one of ordinary skill would interpret the language to actually mean. Since this language is crucial to the definition of the invention and since two opposite interpretations have been set forth with respect to the meaning of the language, the position is taken that the invention has not been adequately described.

2. Claims 1-51 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In view of the position taken with respect to the "degree of liberation" within paragraph 1, the position is taken that the invention has not been adequately enabled. Since it

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cannot be determined with certainty what characteristics the masked isocyanate is to have, the position is taken that one of ordinary skill could not determine what combinations of isocyanates and masking agents are suitable; therefore, one of ordinary skill could not practice the invention.

3. Claims 1-24 and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 1 and 51, it is unclear if the percent value for the degree of liberation is a mole or weight percent. Furthermore, the basis of the percent is unclear. It is not seen that applicants' response has clarified the issue with respect to the type and basis of the percent.

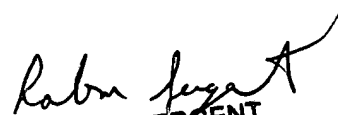
4. Claims 25-50 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for high gloss yielding compositions which are derived from masked isocyanates having a degree of liberation with respect to the masking agent at 120°C of 5% or less, does not reasonably provide enablement for high gloss coating compositions that lack the aforementioned masked isocyanate feature. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The examiner has considered applicants' response and disclosure, and the rejection has been modified accordingly. The position is maintained that applicants have failed to provide adequate enablement for the production of viable compositions when the compositions are not governed by the aforementioned masked

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isocyanate feature. This degree of liberation characteristic appears to be central to the disclosed invention and the position is taken that the claims should be so limited.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent
June 11, 2003


RABON SERGENT
PRIMARY EXAMINER